

This Page Is Inserted by IFW Operations  
and is not a part of the Official Record

## **BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

**IMAGES ARE BEST AVAILABLE COPY.**

As rescanning documents *will not* correct images,  
please do not report the images to the  
Image Problem Mailbox.

## IN THE UNITED STATES PATENT &amp; TRADEMARK OFFICE

Applicants: Zhou (Mike) HONG      Docket No.: 372465-00201  
Serial No.: 10/669,236      Group Art Unit: 2173  
Filed: September 23, 2003      Examiner: Not yet assigned  
For: APPARATUS AND METHOD FOR REDUCING THE MEMORY TRAFFIC OF A GRAPHICS RENDERING SYSTEM

Mail Stop Missing Parts  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF  
PETITION UNDER 37 C.F.R. 1.47(b)

Dear Sir:


This is a response to the Decision Refusing Status Under 37 CFR 1.47(b) mailed May 13, 2004. Enclosed please find the following documents requested to satisfy the requirements listed within the Decision for the above-identified patent application.

1. Declaration, Power of Attorney & Petition signed by Jonathan Chang, an officer of S3 Graphics, Inc. on behalf of Mr. Hong, the non-signing inventor, satisfying item (2) of Decision (*see* Exhibit A); and
2. Copy of executed employment agreement between Mr. Hong and S3 Graphics showing S3 Graphic's proprietary interest in the subject matter satisfying item (5) of the Decision (*see* Exhibit B).

Applicant believes to have satisfied the remaining requirements of the petition and respectfully requests that the Office deem the filing complete and ready for examination, which is respectfully requested.

Respectfully submitted,

Date: July 13, 2004

  
Anthony B. Diepenbroek III  
Registration No. 39,960

DECHERT LLP  
Customer No. 37509

## CERTIFICATE OF MAILING (37 CFR 1.8(a))

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited on July 13, 2004, with the U.S. Postal Service as first class mail in an envelope addressed to: Mail Stop Missing Parts, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450.

Date: July 13, 2004

  
Violette Yuttside-Owen

91393.1.PAL\_17

# Exhibit A

Docket No. 372465-00201

**DECLARATION, POWER OF ATTORNEY AND PETITION**

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled **"APPARATUS AND METHOD FOR REDUCING THE MEMORY TRAFFIC OF A GRAPHICS RENDERING SYSTEM"** the specification of which

☐ is attached hereto  
☒ was filed on September 23, 2003 as Application Serial No. 10/669,236.

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, § 1.56(a).

I hereby claim foreign priority benefits under Title 35, United States Code, § 119 of any foreign application(s) or U.S. provisional application(s) for patent or inventor's certificate listed below and have also identified below any foreign application or U.S. provisional application(s) for patent or inventor's certificate having a filing date before that of the application of which priority is claimed.

**Prior Foreign/U.S. Provisional Application(s)**

			Priority Claimed	
(Number)	(Country)	(Day, month, year filed)	<input type="checkbox"/> Yes	<input type="checkbox"/> No
(Number)	(Country)	(Day, month, year filed)	<input type="checkbox"/> Yes	<input type="checkbox"/> No
(Number)	(Country)	(Day, month, year filed)	<input type="checkbox"/> Yes	<input type="checkbox"/> No

I hereby claim the benefit under Title 35, United States Code, § 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, § 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, § 1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

(Application Serial No.)	Filing Date	(Status: Patented, pending, abandoned)

(Application Serial No.)	Filing Date	(Status: Patented, pending, abandoned)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

*Declaration, Power of Attorney & Petition*

76054.2.PAL\_17 7/6/04 10:23 AM

Docket No. 372465-00201

And I hereby appoint J. BOYCE, REG. 40,920; A.B. DIEPENBROCK III, REG. 39,960; L. SHERRY, REG. 43,918; G. GARCIA, REG. 50,899; H.B. BEDI, REG. 39,904, all associated with DECHERT LLP, P.O. Box 10004, Palo Alto, California 94303, (650) 813-4800, as my attorneys with full power of substitution and revocation, to prosecute said application and to transact in connection therewith all business in the Patent and Trademark Office and before competent International Authorities.

Address all telephone calls to Anthony B. Diepenbrock III, Esq. at (650) 813-4853 and address all correspondence to:

Anthony B. Diepenbrock III, Esq.  
DECHERT LLP  
Customer No. 37509  
P.O. Box 10004  
Palo Alto, CA 94303-0961  
Tel. 650.813.4800  
Fax. 650.813.4848

Wherefore I pray that Letters Patent be granted to me for the invention or discovery described and claimed in the foregoing specification and claims, and I hereby subscribe my name to the foregoing specification and claims, declaration, power of attorney, and this petition.

Full Name of First Inventor: Zhou (Mike) HONG

Home Address: 11512 Country Spring Court, Cupertino, California 95014

Post Office Address: Same as above

Citizenship: P.R. China

Signed by: 

Date: July 2, 2004

Title: SECRETARY

Typed Name: Jonathan Chang, S3 Graphics, Inc.

# Exhibit B

**S3 GRAPHICS****NON-DISCLOSURE, NON-SOLICITATION, WORK PRODUCT/INVENTIONS  
ASSIGNMENT AND CONFLICT OF INTEREST AGREEMENT****I. INTRODUCTION**

This Agreement is made on behalf of S3 Graphics, Inc. (hereinafter "S3G" or the "Company"), with its principal offices located in Santa Clara, California, by Mike Hong (hereinafter "I," "me" or "Employee") and shall be effective as of the first date of my employment with the Company.

I recognize that S3G is engaged in a continuous program of research, development and production with respect to its business, present and future. I understand that as part of my employment by the Company I am expected to make new contributions and inventions of value to the Company. I understand, further, that my employment creates a relationship of confidence and trust between me and the Company with respect to any information (i) applicable to the business of the Company; or (ii) applicable to the business of any client or customer of the Company which may be made known to me by the Company or by any client or customer of the Company, or learned by me during the period of my employment.

**II. AGREEMENT**

In consideration of, and as a condition to, my employment and/or continued employment by S3G or any of its subsidiaries, successors or assigns (herein collectively referred to as "S3G"), I hereby agree to all of the terms contained in this Agreement.

**III. NON-DISCLOSURE OF CONFIDENTIAL INFORMATION.****3.0 I Agree Not To Disclose Confidential Information.**

I agree that during and after the term of my employment with S3G, I shall keep in confidence any proprietary or confidential information of S3G. I understand that this means I shall not use or disclose such information FOR ANY PURPOSE, except to the extent required to perform my work for S3G. I understand that this condition applies whether or not the information is in written form.

**3.1 Definition of Proprietary or Confidential Information.**

Proprietary or confidential information refers to any information not generally known among S3G's competitors and that has commercial value to S3G. By way of illustration, but not limitation, "proprietary" or "confidential" information includes: (i) inventions, trade secrets, ideas, data, programs, works of authorship, know-how, improvements, discoveries, designs,

05/20/04 14:33 FAX

002

techniques and sensitive information the Company receives from its clients; (ii) technical information relating to the Company's existing and future products, including, where appropriate and without limitation, manufacturing techniques and procedures, production controls, software, firmware, information, patent disclosures, patent applications, development or experimental work, formulae, engineering or test data, product specification and part lists, names of suppliers, structures, models, techniques, processes and apparatus relating to the same disclosed by the Company to me or obtained by me through observation or examination of information or developments; (iii) confidential marketing information (including without limitation marketing strategies, customer names and requirements and product and services, prices, margins and costs); (iv) confidential future product plans; (v) confidential financial information provided to me by the Company; (vi) personnel information (including, without limitation, employee names, special skills and experience and compensation); (vii) other confidential business information; and (viii) confidential legal information provided to me by the Company.

### 3.2 What Is Not Confidential Information.

Confidential information does not include any information which becomes public (i.e. is generally known among S3G's competitors) other than as a result of any breach by me of this Agreement.

### 3.3 Third Party Information.

I understand, in addition, that S3G has received and in the future will receive from third parties confidential or proprietary information ("Third Party Information") subject to a duty on S3G's part to maintain the confidentiality of such information and to use it only for certain requested purposes. During the term of my employment and thereafter, I will hold Third Party Information in the strictest confidence and will not disclose or use Third Party Information except as permitted by the written agreement between S3G and such third party.

### 3.4 Information Demanded By Subpoena.

If pursuant to subpoena (or otherwise) during my employment or thereafter, a demand is made upon me to disclose S3G or Third Party proprietary or confidential information by compulsion of law, I shall promptly notify S3G in advance, before responding to the subpoena, of such proposed disclosure to enable S3G to be heard with respect to any such disclosure or to otherwise respond to any such compulsion if it desires to do so.

### 3.5 Returning All Confidential and Work Product Materials Upon Request Or Termination.

All documents, data, records, apparatus, equipment and other physical property, whether or not pertaining to Proprietary Information, furnished to me by the Company, its customers or vendors or by third parties with whom I do business as an employee of the Company, or produced by myself or others in connection with my employment shall be and remain the sole property of the Company and shall be returned promptly to the Company as and when requested by the Company. Should the Company not so request, I shall return and deliver all such property, in any format (written, electronic, or otherwise), upon termination of my employment by me or by the Company for any reason and I will not take with me any such property or any



05/20/04 14:33 FAX

203

reproduction of such property upon such termination. I further agree that any property situated on the Company's premises and owned by the Company, including computers, computer files, e-mail, voice mail, disks and other storage media disks, filing cabinets or other work areas, is subject to inspection by Company personnel at any time with or without notice.

**3.6 Non-Disclosure Of S3G's Confidential Information Extends Beyond Termination.**

I understand that my non-disclosure obligations hereunder shall continue in effect beyond the termination of my employment with S3G. I further understand that I may not disclose the confidential information, as defined hereunder, unless I can first establish that such information is publicly available through no fault or act of mine. This obligation shall be binding on my assigns, heirs, executors, administrators, and other legal representatives.

**IV. NON-SOLICITATION OF CUSTOMERS.**

**4.0 Non-Solicitation of Customers.**

I acknowledge and agree that as part of my performance under this Agreement, I may spend a significant amount of time learning, identifying and developing relationships with actual and prospective customers and learning their individualistic and divergent needs and desires with respect to the S3G's product. The identification of such actual and prospective customers, the development of relationships with them, and the identification of their particular needs and desires all constitute key confidential and proprietary information which has been developed at great expense by S3G and is a principal asset of S3G. By signing below, I acknowledge and agree that in order for me to solicit or to approach in any business manner any S3G customer after the termination of my employment, I would necessarily utilize to some degree S3G's confidential and proprietary information. The use of such proprietary and confidential information would start with the initial contact of the customer and inevitably extend to any discussions with the customer regarding its needs and desires. Therefore, I agree that for one (1) year immediately following the termination of my employment for any reason, I will not, on behalf of myself or any other person or company or business entity, interfere with the business of S3G by soliciting, attempting to solicit, inducing or otherwise causing any customer of S3G to switch its business from S3G to another business entity of any kind.

**4.1 Definition of "Customer."**

For the purposes of this Agreement, the word "customer" means any person, company or other entity who at any time during the two years immediately prior to the date of the termination of my employment with S3G purchased or received from S3G goods, supplies or services, or at the time of the termination my employment with S3G was engaged in active negotiations with S3G relating to the purchase or receipt of such goods, supplies or services.

**4.2 When Not Applicable.**

This section shall not apply to any company customer unrelated to my performance under this Agreement; i.e., any customer which I did not solicit, approach or service in any business

05/20/04 14:33 FAX

204

manner while I was employed by the Company.

## V. NON-SOLICITATION OF EMPLOYEES.

### 5.0 Non-Solicitation Of Employees.

While employed by S3G, and for one (1) year immediately following the termination of employment, I agree not to interfere with the business of S3G by soliciting, attempting to solicit, inducing, or otherwise causing any employee or contractor of S3G to terminate his or her employment in order to become an owner, partner, employee, consultant or independent contractor of/with/to any other business entity. I further agree that, at all times both during my employment by S3G and after its termination, I will not use, reproduce, or disclose to any other person or company, proprietary information belonging to S3G that would enable or assist such person or company to solicit, attempt to solicit, induce, or otherwise cause any employee to terminate his or her employment with S3G.

## VI. CONFLICT OF INTEREST.

### 6.0 General Non-Competition/Conflict Of Interest.

I agree that during the term of my employment by S3G, I will refrain from engaging in any activity outside S3G that will result in a conflict between my self-interest and S3G's interest. I understand that as an employee of S3G, I am expected to observe the highest standards of ethics and good judgment in all transactions relating to my duties for S3G and to review with my immediate supervisors any situation which may conflict with S3G's interests or have the appearance of impropriety.

#### 6.1 Competitive Relationship

I understand that S3G may not collaborate its competitors or their representatives for the purposes of establishing or maintaining prices at any particular level or to collaborate with them in any way in the restraint of trade. S3G prohibits discussion of prices with competitors or disclosing prices to any outside source at any time except for legitimate sales or purchase purposes. The privacy of the methods used to establish prices, terms, and conditions of sale should be constantly maintained without exception.

#### 6.2 Gifts

I understand and agree that every client/customer is entitled to courteous and outstanding service. Since such service is given impartially to all, gratuities are not expected and, further, agree that I shall not accept nor request gifts of any kind from customers or vendors.

## VII. WORK PRODUCT, INVENTIONS AND DISCOVERIES.

06/20/04 14:33 FAX

005

## 7.0 Disclosure.

The products of my work during my employment with S3G are and will become the sole and exclusive property of S3G. I shall promptly and fully disclose to S3G, and with all necessary detail for a complete understanding of the same, all developments, know-how, discoveries, inventions, improvements, concepts, ideas, writings, computer programs, graphic designs, plans, reports, specifications, drawings, written copy, advertising strategies, advertisements, logos, newsletter formats, letterhead styles, formulae, processes and methods of a technological, scientific, graphic, creative or other nature (whether patentable, copyrightable or otherwise) made, received, conceived, acquired or written during working hours or otherwise, by me, solely or jointly with others and whether or not at the request or upon the suggestion of S3G, during the period of my employment with, or rendering of advisory or consulting services to S3G, in or relating to any activities of S3G, to me as a consequence of my employment or the rendering of advisory or consulting services hereunder (collectively the "Subject Matter").

### 7.1 Assignment and Transfer.

I hereby assign and transfer and agree to assign and transfer to S3G all of my rights, title and interest in and to the Subject Matter, and I further agree to deliver to S3G any and all drawings, notes, specifications and data relating to the Subject Matter, and to execute, acknowledge and deliver all such further papers including applications, specifications, oaths, assignments for the patents, trademarks, and copyrights as may be necessary to obtain patents, trademarks and copyrights for any thereof in any and all countries and to vest title thereto to S3G.

Further, I agree to assist S3G by testifying in any prosecution or litigation involving any of the Subject Matter, provided however, that I shall be compensated in a timely manner at the rate of \$75.00 per hour plus out-of-pocket expenses incurred in rendering such assistance of giving or preparing to give such testimony if it is required after termination of my employment hereunder.

### 7.2 Free of Proprietary Rights.

I agree that any assignment of the Subject Matter to S3G is and shall be free of proprietary rights of or encumbrance by any person or entity not a party to this Amendment.

### 7.3 Exception - Labor Code § 2870.

I agree that all such Subject Matter are the sole property of S3G, provided, however, that this Agreement does not require assignment of an Invention which qualifies fully for protection under Section 2870 of the California Labor Code (hereinafter "Section 2870"), which provides in part as follows:

Any provision in an employment agreement which provides that an employee shall assign, or offer to assign, any of his or her rights in an invention to his or her employer shall not apply to an invention that the employee developed entirely on his or her own time without using the employer's equipment, supplies, facilities, or trade secret

05/20/04 14:33 FAX

208

information except for those inventions that either:

- i. Relate at the time of conception or reduction to practice of the invention to the employer's business, or actual or demonstrably anticipated research or development of the employer; or,
- ii. Result from any work performed by the employee for the employer.

As a matter of record I have attached hereto a complete list of all inventions or improvements relevant to the subject matter of any employment by the Company which have been made or conceived or first reduced to practice by me alone or jointly with others prior to my engagement by the Company which I desire to remove from the operation of this Agreement, and I covenant that such list is complete. If no such list is attached to this Agreement, I represent and I have made no such inventions and improvements at the time of signing this Agreement. I acknowledge and agree that the Company and its subsidiaries or affiliates are free to compete or develop information, inventions and products within the areas and the types of inventions described in such list.

#### VIII. SPECIFIC PERFORMANCE.

##### 8.0 Specific Performance.

I agree that if I breach or threaten to commit a breach of, any of the provisions of Section 7 ("Work Product, Inventions and Discoveries"), S3G shall have, in addition and not in lieu of any other rights and remedies available to S3G under law and in equity, the right to have restrictive covenants enforced by any court of competent jurisdiction, it being agreed that any breach or threatened breach of the restrictive covenants same would cause irreparable injury to S3G and that money damages would not provide an adequate remedy to S3G. Notwithstanding the foregoing, nothing herein shall constitute a waiver by my right to contest whether a breach or threatened breach any restrictive covenant has occurred.

#### IX. COMPENSATION FOR WORK PRODUCT, INVENTIONS AND DISCOVERIES.

##### 9.0 Compensation for Work Product, Inventions and Discoveries

In consideration for my assignment of Subject Matter, as described in paragraph VII above (Work Product, Inventions & Discoveries) I accept the compensation, including without limitation salary and expense reimbursement, paid by S3G to me. By my execution hereof, S3G agrees to pay me such compensation in consideration for such Subject Matter and shall gain the sole and exclusive right, title and interest in such Subject Matter.

#### X. MISCELLANEOUS.

05/20/04 14:33 FAX

07

#### 10.0 Non-Disclosure Of Prior Employer's Confidential Information.

I represent that my performance of all the terms of this Agreement and that my employment by the Company does not and will not breach any agreement to keep in confidence Proprietary Information acquired by me in confidence or in trust prior to my employment by the Company. I have not entered into, and I agree I will not enter into, any agreement either written or oral in conflict herewith. During my employment with S3G I will not use or disclose any confidential information or trade secrets, if any, of any former employer, and I have not brought and will not bring onto the premises of S3G or use in the performance of my responsibilities at the S3G any equipment, supplies, facility, electronic media, software or trade secret information of any former employer which are not generally available to the public, unless I have obtained written authorization for their possession and use.

#### 10.1 Freedom To Enter Into This Agreement.

I represent and warrant that I am free to enter into this Agreement and to perform each of the terms and covenants of it. My execution and performance of this Agreement is not a violation or breach of any other agreement between me and any other person or entity.

#### 10.2 Mutual Right Of Termination.

I understand that my employment is of no specific duration, and that my employment shall continue only so long as it is mutually agreeable to both S3G and myself. I understand that either I or S3G may terminate the employment relationship at any time, and for any reason whatsoever.

#### 10.3 All Modifications Must Be In Writing.

This Agreement may not be modified or changed except by a writing signed by both me and the President of S3G.

#### 10.4 Choice Of Law And Severability.

The validity and performance of this Agreement shall be construed and applied in accordance with California law. The provisions of this Agreement are severable, and if any one or more provisions may be determined to be judicially unenforceable, in whole or in part, the remaining provisions shall nevertheless be binding and enforceable.

#### 10.5 Injunctive Relief Available.

I acknowledge and agree that remedies at law for any breach by me of this Agreement will be inadequate and that S3G shall be entitled to injunctive relief, in addition to any other rights and remedies which might be available to S3G.

#### 10.6 Binding Upon Heirs.

05/20/04 14:33 FAX

008

This Agreement shall be binding upon me, my heirs, executors, assigns and administrators and shall inure to the benefit of S3G.

10.7 Consultation With Counsel.

I hereby certify that S3G has advised that I consult with counsel prior to signing this Agreement, and that S3G has given me a reasonable opportunity to raise any issues, questions or concerns that I may have concerning the provisions of this Agreement.

10.8 Fully Integrated Agreement.

I acknowledge receiving a copy of this Agreement and agree that, with respect to its subject matter, it is the entire agreement between me and S3G, and supersedes all previous oral, written and implied communications, representations, understandings or agreements.

IN WITNESS WHEREOF, I have duly executed this Agreement at \_\_\_\_\_  
California on the date written below.

Dated: 09/01/2001

Name: [Signature]

# Copy of Decision



## UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED  
CENTRAL FAX CENTER

JUL 13 2004

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450  
www.uspto.gov

Paper No.

DECHERT LLP  
P.O. BOX 10004  
PALO ALTO, CA 94303

OFFICIAL

COPY MAILED

MAY 13 2004

In re Application of:	:	OFFICE OF PETITIONS
Zhou (Mike) Hong	:	
Application No. 10/669,236	:	DECISION REFUSING
Filed: September 23, 2003	:	STATUS UNDER
Title of Invention: APPARATUS AND	:	37 CFR 1.47(b)
METHOD FOR REDUCING THE MEMORY	:	
TRAFFIC OF A GRAPHIC RENDERING	:	
SYSTEM	:	

This is in response to a petition under 37 CFR 1.47(b), filed March 22, 2004, to allow a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, to make application on behalf of and as agent for all inventors. The one (1) month extension of time requested is hereby granted.

The petition is dismissed.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)", and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on September 23, 2003, without an executed oath or declaration. This Office mailed a Notice to File Missing Parts of Nonprovisional Application (hereinafter "Notice") on December 18, 2003, requiring, *inter alia*, a properly signed oath or declaration and a late filing fee, oath or declaration and surcharge. The Notice further advised Applicant that the oath or declaration failed to identify the citizenship of the inventor.



Application No. 10/669,236

Page 2

In response to the Notice, Applicant files the instant petition wherein Applicant avers that the nonsigning inventor refuses to join in the application. Applicant has not filed an oath or declaration in compliance with 37 CFR 1.63 in response to the Notice. Applicant also files a copy of an Employment Verification Letter from the Human Resources Manager at S3 Graphics.

Applicable Law

A grantable petition under 37 CFR 1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor(s); (5) proof of proprietary interest; and (6) proof of irreparable harm. Applicant lacks items (2) and (5).

As to item (2), the Office notes that pursuant to Section 409.03(b)(A) of the Manual for Patent Examining Procedure:

Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation. Where the oath or declaration is being signed on behalf of an assignee, see MPEP Section 324. An inventor may not authorize another individual to act as his or her agent to sign the application oath or declaration on his or her

Application No. 10/669,236

Page 3

behalf. *Staeger v. Commissioner*, 189 USPQ 272 (D.D.C. 1976), *In re Striker*, 182 USPQ 507 (Comm'r Pat. 1973). (Emphasis supplied). Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b).

Applicant has not presented an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 37 CFR 1.64. A properly executed oath or declaration is required.

As to item (5), applicant failed to show or provide proof that S3 Graphics has sufficient proprietary interest in the subject matter to justify the filing of the application (see MPEP 409.03(f)). Acceptable proof would include a copy of the employment agreement between the non-signing inventor and the Rule 47(b) applicant (company), a copy of an assignment agreement showing that the invention disclosed in the application is assigned to the Rule 47(b) applicant, or a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would by the weight of authority in that jurisdiction award the title of the invention to the Rule 47(b) applicant.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

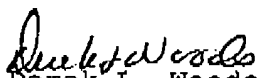
By FAX: (703) 872-9306  
Attn: Office of Petitions

By hand: 2201 South Clark Place  
Customer Window  
Crystal Plaza Two, Lobby Room 1B03  
Arlington, VA 22202

Application No. 10/669,236

Page 4

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0014.

  
Derek L. Woods  
Petitions Attorney  
Office of Petitions